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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,226	11/12/2003	John W. Rohrer		6313

7590 06/16/2004
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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,226	Applicant(s) ROHRER, JOHN W.	
	Examiner Nini F. Legesse	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to because on Figure 3, Applicant is showing item 26 (the center of the golf hole 28) at two different locations. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 10 is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not show a weight of "50 grams" for the mounting base.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure, which goes to make up the device, must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. Few examples are given below to show why the claims are indefinite:

With respect to claim 1, the expression " the appearance of a golf ball, or similarly sized white or light colored circle or disc" on lines 1-2 is indefinite because it is not clear as to what Applicant is claiming. Is he claiming a sphere, a disc or something else? The

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expression "other energy source" on lines 4-5 is unclear. It is not clear what Applicant considers to be other energy source.

With respect to claim 2, the expression " other visible light source" in line 2 is indefinite because it is not clear what the other visible light sources are referring to.

With respect to claim 3, the expression " other non-visible light source" in line 2 is indefinite because it is not clear what the other visible light sources are referring to.

With respect to claim 6, what are the "other means" on line 4?

With respect to claim 8, the phrases "such as" and "or the like" renders the claim indefinite because the claimed apparatus includes elements not actually disclosed (those encompassed by "or the like") and the scope of the claim is unascertainable.

With respect to claim 9, the phrase "other suitable means" renders the claim indefinite because the claimed apparatus includes elements not actually disclosed and the scope of the claim is unascertainable.

AS BEST UNDERSTOOD THE CLAIMS ARE REJECTED AS FOLLOWS:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Halsey et al. (US Patent No. 5,725,439).

With respect to claim 1, Halsey discloses a light mechanism that is attached to the front of a golf club (1).

With respect to claim 2, the focused beam is a laser beam (52).

With respect to claim 6, mounting base (24) is rigidly attached to the putter head.

With respect to claim 9, the device has magnetic attachment member 24 that enables it to be adjustable in height.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 7, 8, 9, 11 and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Hambly (US Patent No. 6,579,191).

With respect to claim 1, Hambly discloses a light mechanism (40) that is unattached to the front of a golf club (as shown on Fig. 1).

With respect to claim 2, the focused beam is a laser beam (40).

With respect to claims 5 and 7, mounting base (20 and 60) is set on the ground or a floor unattached to the club head and the beam is at Norman angle to the clubface (referring to Fig. 1, wherein item 37 is on a horizontal position as shown as a hidden line).

With respect to claims 8 and 9, mechanical means (52) is considered as one of other suitable means that allows the beam of the device to maintain its height or attitude relative to the ground.

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With respect to claim 11, the device has elastomer bottom with small projections (see column 3, lines 17-22).

With respect to claim 12, the device has a switch (54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halsey in view of Official Notice.

Halsey discloses the use of a laser source (52). However, the use of any other type of light mechanism including infrared, radio frequency or electro-magnetic sources would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the training device with any one of them since the examiner takes Official Notice of the equivalence of the above listed sources for their use in the golf art and the selection of any of these known equivalents to provide light in a training device would be within the level of ordinary skill in the art.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hambly. The device of Hambly appears to weigh above 50 grams.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halsey in view of Ogden (US Patent No. 5,374,063).

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Halsey fails to show a switch that is located on the grip section of the club. However positioning a switch on grip area is old in the golf art. Ogden is one reference among many that teaches a grip area switch location (see item 32 on Fig. 1). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to position switch (58) of the Halsey's invention at the grip area of the club in order to make the switch easily accessible to the user so that he/she would not have to bend to actuate the switch.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL
06/10/04


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